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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO
08/874,460	06/16/97	WEI	

EXAMINER

STERN KESSLER GOLDSTEIN & FOX
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WASHINGTON DC 20005-3934

18N2/0121

ART UNIT	PAPER NUMBER
DRAPER, G	4

DATE MAILED: 01/21/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☐ Claim(s) _____ is/are rejected.
☐ Claim(s) _____ is/are objected to.
☒ Claim(s) 1-20 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

1. A telephone call was made to Kimberlin M. Toohey on 1-7-98 to request an oral election to the above restriction requirement, but did not result in an election being made. Ms Toohey expressly requested a written restriction requirement

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-14 and 17, drawn to nucleic acid, vectors, host cells and method of making the chemokine beta 15, classified in classes 536 and 435, subclasses 23.5 and 69.5.

II. Claims 15 and 18, drawn to chemokine beta 15, classified in class 530, subclass 351.

III. Claims 16, drawn to antibodies, classified in class 530, subclass 389.2.

IV. Claims 19, drawn to methods of treatment using the protein, classified in class 424, subclass 85.1.

V. Claims 20, drawn to methods of diagnosing or disease, classified in class 435, subclass 6+.

The inventions are distinct, each from the other because:

Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the protein can be made by a materially different process other than with the use of the NA, vectors and host cells of Group I such as by chemical synthesis, or the isolation from nature using various isolation/purification/chromatographic procedures. Further, the NA of Group I can be used other than to make the protein of Group II, such it their use as probes, or their use in various diagnostic procedures or in various therapeutic procedures, and the products of these two groups constitute structurally, physically, and functionally distinct products.

Inventions Group II, and Group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein can be used in a materially different method such as its use as a probe, to make antibodies, or in various diagnostic or other therapeutic methods.

Inventions Group I and Groups V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acids can be used as a probe, to make transgenic animals, or in the various diagnostic or therapeutic methods as listed above.

It is further pointed out that although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for multiple/different products, restriction is deemed to be proper because the products appear to constitute patentably distinct inventions. The inventive products of Groups I, II, & III, are directed to products that are structurally, physically and functionally distinct and if determined to be patentable they would also be patentably distinct. Furthermore, these products are not required one for the other, nor for each of the methods of Groups I, IV or V.

In a similar manner it is further pointed out that although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for multiple/different methods, restriction is deemed to be proper because the methods appear to constitute patentably distinct inventions. The inventive methods of Groups I, IV & V require the use of different steps/methods; elements/agents that are physically and functionally distinct; there are different starting elements and the final outcome/results are different for these different methods that cover

various diagnostics and therapeutic methods; and if determined to be patentable they would also be patentably distinct. . Furthermore, these methods are not required one for the other, nor do they require the use of each of the products of Groups I----->III

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications which are not co-extensive. And there are different issues for the search and examination of each group, which would be unduly burdensome, accordingly, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. Any inquiry concerning this communication should be directed to Garnette D. Draper at telephone number (703) 308-4232.

GARNETTE D. DRAPER
PRIMARY EXAMINER
GROUP 1800